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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/452,658	05/25/1995	WALTER C. FIERS	B8/B8-CIP-DI	5499
7590	03/27/2007	JAMES F HALEY JR FISH AND NEAVE 1251 AVENUE OF THE AMERICAS NEW YORK, NY 100201104	EXAMINER MARTINELL, JAMES	
			ART UNIT 1634	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE 03/27/2007	DELIVERY MODE PAPER	
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**GROUP 1F**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 08/452,658

Filing Date: May 25, 1995

Appellant(s): FIERS, WALTER C.

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James F. Haley, Jr.  
For Appellant

**SECOND EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 4, 2006 appealing from the Office action mailed May 28, 2004.

The Examiner's Answer mailed September 26, 2005 contained a new ground of rejection under *res judicata*. The new ground of rejection under *res judicata* (Examiner's Answer mailed September 26,

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2005, page 5) is withdrawn in view of Appellant's arguments and supporting documents filed November 23, 2005. Since Appellant has remedied the deficiencies in the Brief (see the USPTO communication mailed June 2, 2006) and since the new ground of rejection in the Examiner's Answer mailed September 26, 2005 is withdrawn, the Amended Appeal Brief filed December 4, 2006 is proper and addresses all of the issues on appeal. Accordingly, the application is forwarded to the Board of Patent Appeals and Interferences.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows.

Appellant states (brief, page 4, section VI) that claims 31, 33, and 34 are rejected under 35 U.S.C. § 102(g). This is incorrect. Claims 31 and 34 are rejected under 35 U.S.C. § 102(g). Claim 33 was not rejected under 35 U.S.C. § 102(g) because the nucleotide sequence recited in claim 33 differs at codon 30 from the nucleotide sequence in the Sugano et al patents at one nucleotide. In Sugano et al '859, Table 5, columns 11-12 codon 30 is "TAT" (encoding TYR, tyrosine), in Sugano et al, '567, Table 5, columns 11-12 codon 30 is "TAT" (encoding TYR, tyrosine), and in claim 33 of the instant application codon 30 (*i.e.*, nucleotides 88-90) is "TAC" (encoding TYR, tyrosine).

**GROUNDS OF REJECTION NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 31, 33, and 34 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 37 of copending Application No. 08/253,843 and claims 31, 33, and 34 of copending Application No. 08/449,930. Appellant has agreed to file one or more appropriate Terminal Disclaimers or to cancel conflicting subject matter (see the response filed November 24, 2004, page 2, last full paragraph).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (*e.g.*, patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Sugano et al, U.S. Patent No. 5,514,567, issued May 7, 1996.

Sugano et al, U.S. Patent No. 5,326,859 issued July 5, 1994.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 31 and 34 are rejected under 35 U.S.C. § 102(g) as being clearly anticipated by either one of Sugano et al (U.S. Patent No. 5,514,567) or Sugano et al (U.S. Patent No. 5,326,859). Each of the Sugano et al patents discloses a DNA that encodes the same amino acid sequence as is recited in claim 34 of the instant application (*e.g.*, see Table 5 at columns 11-12 in each of the references). Additionally the DNA in Table 5 of each of the Sugano et al references would hybridize to the DNAs mentioned in claim 31 of the instant application because the DNA in Table 5 of each of the Sugano et al references differs by only one nucleotide (at codon 30) from the DNA recited in claim 33 of the instant application) and also encodes a beta-interferon. Thus, the DNA of Sugano et al is embraced by claim 31, parts 1) (a) and 1) (b) of the claim. The use of beta-interferon to stimulate the immune system in the treatment of human cancers and for viral diseases is disclosed in each of the Sugano et al references at column 1, lines 10-30) and the expression of DNA encoding beta-interferon in heterologous non-human hosts is taught in Sugano et al '567 at column 15 and claims 21-31 and in Sugano et al '859 at column 16. Thus, the methods taught in each of the Sugano et al references are embraced by claims 31 and 34 of the

instant application. The U.S. Court of Appeals for the Federal Circuit concluded (*Fiers v. Sugano*, 25 USPQ2d 1601, U.S. Court of Appeals for the Federal Circuit, decided January 19, 1993),

that Sugano is entitled to rely on his disclosure as enabling since it sets forth a detailed teaching of a method for obtaining a DNA coding for  $\beta$ -IF and the Board did not err in determining that Fiers presented no convincing evidence impeaching the truth of the statements in Sugano's patent specification. We also conclude that Sugano's application satisfies the written description requirement since it sets forth the complete and correct nucleotide sequence of a DNA coding for  $\beta$ -IF . . . . The Board correctly determined that Sugano's March 19, 1980 Japanese application satisfies the requirements of section 112, first paragraph, and that Sugano thus met his burden to establish entitlement to that filing date.

Appellant's arguments (brief, pages 4-6) are not convincing. Appellant complains that there is no evidence of record to indicate that Sugano et al had completed an actual reduction to practice of the invention in this country prior to appellant's effective U.S. filing date. The instant application and the two Sugano et al patents disclose the same amount of information relevant to the methods claimed in the instant application. Appellants have not disagreed with this fact. Since the Court of Appeals for the Federal Circuit has already determined that Sugano et al are entitled to priority (*Fiers v. Sugano*, 25 USPQ2d 1601, Fed. Cir. 1993) for what is for interference purposes a patentably indistinct invention, the rejection under 35 U.S.C. § 102(g) should be sustained.

#### **(10) Response to Argument**

The response to appellant's arguments are contained in section (9) above.

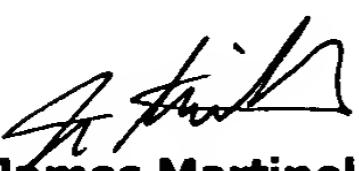
#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

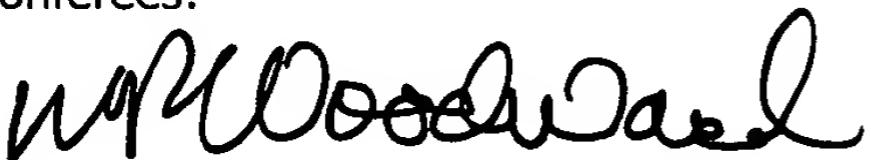
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For the above reasons, it is believed that the rejections should be sustained.

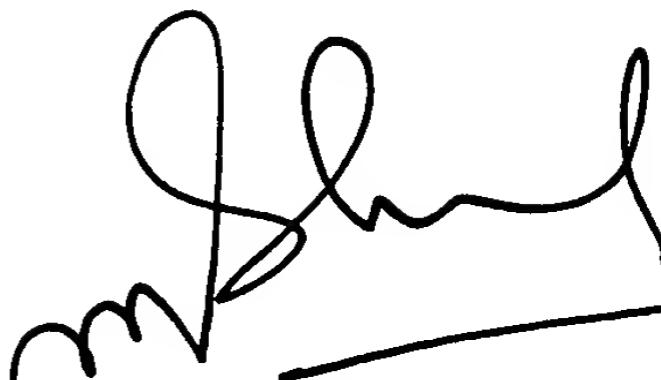
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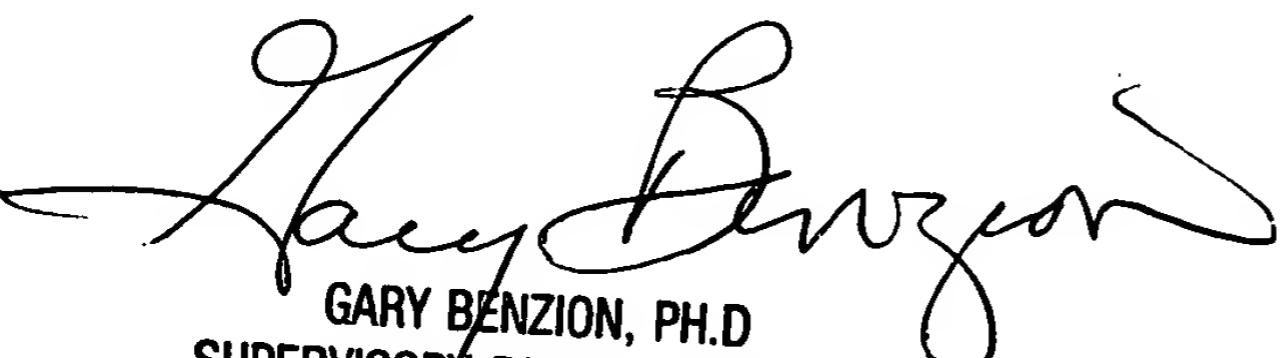
  
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